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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,217	07/08/2003	Ellis T. Cha	2855/97	7311
23838	7590	11/29/2004	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			CHEN, TIANJIE	
			ART UNIT	PAPER NUMBER

2652

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,217	<b>Applicant(s)</b> CHA, ELLIS T.	
	<b>Examiner</b> Tianjie Chen	<b>Art Unit</b> 2652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## ***Non-Final Rejection***

### ***Claim Objections***

1. Claims 1 and 9 are objected to because of the following informalities:

- In claim 1, line 8; "the" should be deleted.
- In claim 9, line 8; "the" should be deleted.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1–4 and 7–17 are rejected under 35 U.S.C. 102(e) as being anticipated by Pendray et al (US 6,678,119).

Claim 1: Pendray et al shows a subambient pressure air bearing slider in Fig. 2 including: a slider body defined by a leading edge 130, an inner and outer edge 132 and 133 extending longitudinally along the slider body, and a trailing edge 131 (Column 4, lines 7 and 8), the slider body including a leading air bearing surface 152 (Column 4, line 28); a leading portion 144 extending from the leading edge of the slider, the leading portion having a first height lower than a height of the leading air bearing surface (Column 4, lines 45–48); a subambient pressure region 146 extending between the leading portion and between the first and second low-profile members 220

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and 222 (Fig. 2; column 40-42), the low-profile members having a height that is less than the height of the leading air bearing surface (Column 4, lines 45-48).

Claim 2: Pendray et al shows that the height of the first and second low-profile members is equal to the first height (Column 4, lines 45-48 and column 6, lines 24-26).

Claim 3: Pendray et al shows that the slider is to be used in an ultra low flying height environment for a disk drive (Column 2, lines 9-11).

Claim 4: Pendray et al show a trailing air bearing surface 162 (Column 4, line 59) including a first rectangular portion facing the leading edge of the slider and a second rectangular portion facing the trailing edge of the slider (Fig. 2).

Claim 7: In Pendray et al's device, width of the second rectangular portion is inherently limited to mask alignment tolerances in photolithographic process to manufacture the slider.

Furthermore, a "product by process" claim is directed to the product per se, no matter how actually made, see *In re Hirao*, 190 USPQ 15 at 17 (footnote 3 CCPC, 5/27/76); *In re Brown*, 173 USPQ 685 (CCPA 5/18/72); *In re Luck*, 177 USPQ 523 (CCPA, 4/26/73); *In re Fessmann*, 180 USPQ 324 (CCPA, 1/10/74); *In re Thorpe*, 227 USPQ 964 (CAFC, 11/21/85). The patentability of the final product in a "product by process" claim must be determined by the product itself and not the actual process and an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Therefore, the limitation of "limited to mask alignment tolerances in photolithographic process to manufacture the slider" is process related and will not gain weight in determining patentability.

Claim 8: Pendray further shows a read/ write element 164 (Column 4, lines 63-64) , wherein the second rectangular portion is disposed over the read/ write element.

Claim 9: Pendray et al shows a subambient pressure air bearing slider in Fig. 2 including: a slider body 110 defined by a leading edge 130, an inner and outer edge 132 and 133 extending longitudinally along the slider body, and a trailing edge 131 (Column 4, lines 7-9), the slider body including a leading air bearing surface 152; a leading portion 144 extending from the leading edge of the slider, the leading portion having a first height lower than a height of the leading air bearing surface; a subambient pressure region extending between the leading portion and between the first and second low-profile members 220, the low-profile members having a height that is less than the height of the leading air bearing surface; at least one side air bearing surface 154 (Column 4, lines 45-47), wherein a placement of the side air bearing surface and a width of the side air bearing surface in the longitudinal direction of the slider are selected to achieve a predetermined flying height sensitivity to crowning in the slider.

Claim 10: Pendray et al shows a width of the side air bearing surface in a latitudinal direction of the slider is inherently selected to achieve a predetermined flying height sensitivity to camber in the slider.

Claim 11: Pendray et al shows that low-profile members 220 are not air bearing surfaces.

Claim 12: the above described Pendray et al's device includes a method of designing a subambient pressure air bearing slider including a slider body defined by a leading edge, an inner and outer edge extending longitudinally along the slider body, and a trailing edge, the slider body including a leading air bearing surface and a

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leading portion extending from the leading edge of the slider, the leading portion having a first height lower than a height of the leading air bearing surface, the method including: selecting a width, in a longitudinal direction for the slider body, of a side air bearing surface and a position for the side air bearing slider to achieve a predetermined flying height sensitivity to crowning in the slider.

Claim 13: the above described Pendray et al's device the width in the longitudinal direction for the slider body, of a trailing air bearing surface is selected to achieve the predetermined flying height sensitivity to crowning in the slider (Column 3, lines 61-67).

Claim 14: the above described Pendray et al's device inherits selecting a width, in a lateral direction for the slider body, of the side air bearing surface to achieve a predetermined flying height sensitivity to camber in the slider.

Claim 15: the above described Pendray et al's device, the flying height sensitivities to crown and camber offset each other for the slider (Column 3, lines 60-65).

Claim 16: the above described Pendray et al's device includes positioning two low-profile members behind the leading air bearing surface and the leading portion to define a subambient pressure region.

Claim 17: the above described Pendray et al's device the trailing air bearing surface includes a leading rectangular portion and a trailing rectangular portion, the method further including: selecting a width, in the lateral direction for the slider body, of the trailing rectangular portion of the trailing air bearing surface to achieve a desired flying height for the slider.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendray et al.

Claim 5: Pendray et al show that in one embodiment the slider 110 has a width of 1.01 mm (40 miles) and other large and small slider sizes can also be used (Column 4, lines 10-15). One of ordinary skill in the art would have been reasonably expecting the second rectangular portion has a width of less than approximately 30 mils.

Claim 6: Pendray et al does not specifically show that the second rectangular portions have a width of approximately 5 mils.

However, Applicant does not show unexpected results resulted from the particular width of 5 miles, not 4 or 6 miles. One of ordinary skill in the art would have found a suitable width from experimentation and optimization. As taking the size suggested by Pendray into account, one of ordinary skill in the art would have been expecting the results from the experimentation would include the width of approximately 5 miles.

***Conclusion***

4. The prior art made of record in PTO-892 Form and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is (703) 305-7499. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Chen Tianjie*  
**TIANJI CHEN**  
**PRIMARY EXAMINER** 11/22/2004